IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Griffin, et al.	Art Unit: 2173
Application No.: 10/783,901	Examiner: Namitha Pillai
Filed: February 20, 2004	Attorney Docket No.: 555255-012551
For: PREDICTIVE TEXT INPUT SYSTEM FOR A MOBILE COMMUNICATION DEVICE	**REPLY BRIEF**

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is filed in response to the Examiner's Answer mailed February 23, 2009. The Commissioner is hereby authorized to charge any necessary fees and credit any overpayment associated with this Appeal to Jones Day Deposit Account No. 501432, ref: 555255-012551.

I. The Rejection of Claims 1 and 18 Under 35 U.S.C. § 103(a) over Williams in View of Suess is Improper

A. The Examiner's Interpretation of the "Ambiguous Word List" Claim Limitation Is Not Supported by the Language of the Claim

Claims 1 and 18 recite "*an ambiguous word list comprising a plurality of keystroke combinations, each keystroke combination representing a plurality of key selections on the reduced key QWERTY keyboard, wherein the keystroke combinations present in the ambiguous word list are associated with more than one common predicted word.*" In the Examiner's Answer, the Examiner argues that this claim limitation is disclosed by the Williams reference because Williams describes a system where each time a string of key stokes is entered by a user, a list of possible matching words is displayed as the user is typing. The Examiner interprets this list of matching words as the "ambiguous word list" recited in claims 1 and 18. (*See*, Examiner's Answer, pages 8-9). However, this conclusion overlooks the specific language of the claims and thus cannot be correct.

The "ambiguous word list" recited in claims 1 and 18 comprises a plurality of keystroke combinations, with each keystroke combination representing a plurality of key selections on the reduced QWERTY keyboard, and wherein the keystroke combinations present in the ambiguous word list are associated with more than one common predicted word. That is, the claimed ambiguous word list specifically requires a list that correlates multiple possible keystroke combinations with their associated common predicted words. Creating a list of possible word choices for one keystroke combination as the keystrokes are entered by a user clearly does not

meet this claim limitation. The Examiner's interpretation is therefore not supported by the language of the claims and cannot stand.

B. The Examiner's Interpretation of the "Alert Mechanism" Claim Limitation Is Clearly Unreasonable

Claims 1 and 18 further recite an alert mechanism that is engaged on the mobile device if the input keystroke combination is present in the ambiguous word list. The Examiner's Answer argues that this claim limitation is disclosed in the Williams reference because Williams teaches that a user may select a word from a list of possible words, and that when this word is selected it is somehow marked in the list to indicated that the word has been selected by the user. The Examiner further argues that marking the word in the list "alerts" the user to the word. First, the ability of a user to highlight or otherwise "mark" a word in a list is clearly not a "mechanism that is engaged on a mobile device" upon the determination that an input keystroke is present in an ambiguous word list. The actions of the user cannot reasonably be construed as an "alert mechanism" within the context of the patent's specification or within the common sense meaning of the words. Further, the user's own marking of a word in a list does not provide any sort of "alert" within the commonly understood meaning of the word. Accordingly, the Examiner's interpretation of this claim element is clearly incorrect.

II. The Rejection of Claims 3 and 20 Under 35 U.S.C. § 103(a) over Williams in View of Suess is Improper Because the Cited References Fail To Disclose a Grammar Rules Database

Claims 3 and 20 recite "*a grammar rules database, wherein if the predicted text system determines that there is more than one predicted word associated with the keystroke combination, it determines the predicted word by applying a set of grammar rules from the*

grammar rules database to the input keystroke combination." The Examiner's Answer equates this limitation with the standard dictionary described in the Williams reference because the dictionary allows the user to "customize" words and because certain words in the dictionary may be capitalized. According to the Examiner's reasoning, because the words in Williams' standard dictionary may take into account grammar (such as capitalizing the first letter in a proper name), it is a grammar rules database as recited in the claims. This interpretation is clearly incorrect because is takes the claim language completely out of context of both the specification and the claim itself.

Claims 3 and 20 do not just recite a "grammar rules database" in a void. They claim a grammar rules database that may be used to determine a predicted word from more than one predicted word associated with a particular keystroke combination by applying a set of grammar rules to the input keystroke combination. Williams's disclosure of a standard customizable dictionary with capitalized proper nouns certainly cannot satisfy this claimed function, and therefore cannot reasonably be interpreted to read on the claimed "grammar rules database."

III. The Rejection of Claims 7 and 24 Under 35 U.S.C. § 103(a) over Williams in View of Suess and Schroeder is Improper Because the Cited References Fail To Disclose the Use of a Vibration Device as an Alert Mechanism Within a Predictive Text System

Claims 7 and 24, which respectively depend from claims 1 and 18, add that the "alert mechanism is a vibration device." In rejecting these claims, the Examiner cites to a standard cellular phone vibrator disclosed in the Schroeder reference that vibrates when a phone call is received. The Examiner's Answer explains that it would be obvious to combine this standard cellular phone vibrator with the Williams reference to provide a vibratory alert when the user "marks" words in a list. By this logic, when the user of Williams' mobile phone selects (*i.e.*, "marks") a word from a list of possible words in the dictionary, his phone would vibrate to "alert" him that he has made the selection. What possible motivation could there be for using a vibratory alert in this manner? A user does not need to be "alerted" that he has selected an item from a list. The absurdity of this scenario further highlights that the Examiner's interpretation of the claimed "alert mechanism" to read on the user's own selection of items from a word list is unreasonable and cannot be correct.

Respectfully submitted,

Date: 4/16/9

By: _____

Joseph M. Sauer, Reg. No. 47,919
Jones Day
North Point
901 Lakeside Ave.
Cleveland, Ohio 44114
(216) 586-7506